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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,034	12/14/2000	Werner Obrecht	Mo-5842/LcA 34,092	4130

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LANXESS CORPORATION  
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PITTSBURGH, PA 15275-1112

EXAMINER
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SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1796

MAIL DATE	DELIVERY MODE
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12/21/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

09/739,034

Applicant(s)

OBRECHT ET AL.

Examiner

Rabon Sergeant

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-10 and 23-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-10 and 23-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

1. Claims 8-10 and 23-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Adequate support has not been provided for the amendment specifying that the rubber vulcanate or rubber body is non-adhesive. Applicants have argued that support stems from paragraph 5 of the published application; however, the argued citation refers to prior or known compositions, as opposed to the instant composition. Furthermore, the cited statement that prior or known compositions adhere to the metal parts of a mold in no way establishes that the instant composition lacks this property, even to a lessened degree. In the instant case, it is not seen how one can justify stating that their composition does not have a certain property simply because other compositions possess the property. Additionally, applicants have in no way defined exactly what is meant by non-adhesive. Molding compositions, by their very nature, inherently possess some degree of adhesiveness; therefore, absent some language defining what is meant by the language, it cannot be determined exactly what degree of non-adhesiveness is encompassed by the language. Furthermore, the argued citation merely refers to the metal parts of molds; therefore, the citation in no way can be construed to provide support for the composition being non-adhesive relative to other surfaces or substrates; however, the language of the amendment suggests exactly this.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 8-10 and 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obrecht et al. ('488) or DE 19701487, each in view of Dammann et al. ('531) or JP 57-212239 or JP 5-17630.

The primary references disclose rubber mixtures comprising double bond containing rubber and crosslinked rubber particles having applicants' claimed properties, wherein the mixtures are useful for producing vulcanisates and molded articles. See abstract; column 1, lines 31+; columns 2 and 3; and column 4, lines 49-59. See abstract and page 4, line 3 within DE 19701487. Though the primary references are silent regarding the addition of a polyisocyanate component to the composition, the use of polyisocyanates within rubber mixtures to improve physical properties was known at the time of invention. This position is supported by the teachings of the secondary references. The secondary references disclose that polyisocyanate containing rubber formulations display excellent moldability and bonding resistant to heat and humidity. See abstracts. In view of the fact that applicants have failed to define "non-adhesive"

and in view of the fact that the disclosures of the primary references disclose analogous compositions and utilities to those of applicants, the position is taken that the primary references are similarly "non-adhesive".

4. Therefore, it would have been obvious to incorporate polyisocyanates within the rubber mixtures of the primary references, so as to produce rubber compositions having the improved moldability and bonding characteristics taught by the secondary references. This position is bolstered by the fact that it has been held that it is *prima facie* obvious to utilize a known component for its art recognized purpose. *In re Linder*, 173 USPQ 356. *In re Dial et al.*, 140 USPQ 244.

5. Applicants' arguments have been considered; however, they are insufficient to overcome the prior art rejection. Applicants' argue that since the relied upon secondary references, Dammann et al. and JP 5-17630, are drawn to adhesives there is no motivation to combine the references or to rely upon the teachings of the secondary references to employ an isocyanate within the compositions of the primary references. In response, the position is taken that applicants have failed to establish that the claimed vulcanates and adhesives are mutually exclusive. It would seem that all moldable compositions, prior to cure, would have an adhesive property and, once cured, it is logical to conclude that adhesives would lack an adhesive or tacky property or have a significantly reduced adhesive property. Despite applicants' arguments concerning the presence of a tackifying resin, applicants have not established that the cured adhesives of Dammann et al. would not be non-adhesive to the same extent claimed by applicants. Furthermore, it is specifically noted that Dammann et al. recite that curatives may be used at column 3, lines 47-51 and that one of these curatives is sulfur, a known vulcanizing

agent. Applicants' remarks concerning the lack of a vulcanization step are not well-taken; the fact remains that Dammann et al. disclose curatives; therefore, patentees clearly provide for embodiments where curatives are present and are expected to perform a curative function. Furthermore, given the use of polyisocyanates and components containing active hydrogen groups, the position is taken, depending on the functionality of the reactants, that one would reasonably expect the composition of JP 5-17630 to be crosslinked or vulcanized once cured. Therefore, applicants have by no means established that the secondary references do not encompass vulcanates, once the adhesives are cured, or that the resulting compositions would not be expected to be non-adhesive to the same extent as applicants' composition. Regarding applicants' argument that JP 5-17630 fails to teach or suggest the claimed amount of isocyanate component, the position is taken that the respective disclosed quantity ranges do in fact overlap, though only to a limited extent. Applicants' arguments with respect to JP 57-212239 are not well taken. Applicants' arguments amount to unsubstantiated opinion that cannot substitute for fact. Applicants have not established that the argued properties are not due to the isocyanate component. Furthermore, applicants' remarks are not commensurate in scope with the claims, because applicants' claims fail to exclude the argued phenolic resins.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (571) 272-1079.

R. Sergent  
December 19, 2007

  
RABON SERGENT  
PRIMARY EXAMINER